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| Michael D. Bednarek Shaw Pittman LLP 1650 Tysons Boulevard McLean, VA 22102 | | | MEINECKE DIAZ, SUSANNA M | |
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| | | | 3623 | |
| DATE MAILED: 12/30/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/840,216 | PARKER ET AL. | |
| | Examiner | Art Unit | |
| | Susanna M. Diaz | 3623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 December 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 and 12-22 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-9 and 12-22 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/6/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed December 6, 2005.

Claims 1, 2, 6, 14, 18, 20, and 22 have been amended.

Claims 10 and 11 have been cancelled.

Claims 1-9 and 12-22 are presented for examination.

2. The previous claim objection is withdrawn in response to Applicant's persuasive argument.

Several, but not all, of the previous rejections under 35 U.S.C. § 112, 1st and 2nd paragraphs are withdrawn. Those that have not been withdrawn are reiterated and argued below.

The Examiner thanks Applicant for the thorough response to the Requirement for Information under 37 C.F.R. § 1.105.

Response to Arguments

3. Applicant's arguments filed December 6, 2005 have been fully considered but they are not persuasive.

Regarding the rejections under 35 U.S.C. § 112, 1st and 2nd paragraphs, for lack of concreteness, "Applicants respectfully submit that each of the independent claims 1, 14, and 20 results in an undoubtedly tangible product embodied in a display, which could be on paper, on a computer graphical user interface, or any other means of

display...Thus, as embodied in the various displays, independent claims 1, 14, and 20 all provide concrete, tangible results." (Pages 12-13 of Applicant's response) It should be noted that tangibility and concreteness set forth two separate standards that must be met by a claimed invention. While an output may be displayed on a computer screen, the nature of the output itself must be analyzed in order to assess whether or not the invention is concrete. As stated in the rejections, a claimed invention must produce consistent, repeatable, and reproducible results in order to meet the requirements of 35 U.S.C. § 112 as well as § 101. In other words, a methodology that relies *purely* on subjective input and analysis is not concrete because one of ordinary skill could not make and use the invention as intended without undue experimentation. Depending on who performs the recited functionality, a completely different result could be obtained. The results of the claimed invention are unrepeatable and unpredictable. Support for Examiner's rationale may be found on page 22 of the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility"
[\(http://www.uspto.gov/web/offices/pac/dapp/ola/preognotice/guidelines101_20051026.pdf\)](http://www.uspto.gov/web/offices/pac/dapp/ola/preognotice/guidelines101_20051026.pdf).

Regarding the § 112, 2nd paragraph rejection of claims 7, 8, and 16, "Applicants respectfully submit, however, that this rejection if based on a misunderstanding of the term 'outsourcer.' As defined in the present application at, for example, paragraphs [0004-5], an outsourcer is defined as the entity to which an operation is outsourced." (Page 14 of Applicant's response) First, it should be noted that Applicant's use of the word "outsourcer" is contrary to the generally accepted meaning of the term. For

Art Unit: 3623

example, Merriam Webster's Collegiate® Dictionary (10th ed) defines *outsourcing* as "the practice of subcontracting manufacturing work to outside and esp. foreign or nonunion companies." The suffix "-er" means one who performs the root of the word; therefore, an outsourcer would be one who performs the practice of subcontracting manufacturing work to outside and esp. foreign or nonunion companies (and not one who receives the outsourced assignment, as submitted by Applicant). Second, while Applicant may be his/her own lexicographer, the claims do not further define "outsourcer" and it is not clear that the cited paragraphs [0004-5] of the specification are meant to provide a special definition of "outsourcer." In Applicant's own arguments, the "outsourcer" is equated to "the entity to which an operation is outsourced" while the background of Applicant's specification would, at best, provide a special definition of an "outsourcer" as being "a supplier." Based on Applicant's own arguments, Applicant does not intend to narrowly limit the claimed "outsourcer" to a supplier *per se*; therefore, the Examiner does not currently recognize the specification's correlation between an "outsourcer" and a "supplier" as a special definition. The claims should be amended to further limit Applicant's intended metes and bounds of an "outsourcer" if such a narrow interpretation is desired by Applicant and supported by the original disclosure.

Regarding Applicant's arguments relating to the rejection under 35 U.S.C. § 101, the technological arts requirement is withdrawn; however, the rejection of the claims for failure to produce a concrete result is maintained for the reasons discussed above.

Applicant argues that "Barton fails to teach or suggest the display of an association between a process, element, and actor on a single display, which conveys

the scope of an outsourcing transaction." (Page 15 of Applicant's response) The Examiner respectfully disagrees. As stated in the art rejection, the Examiner submits that Fig. 4 and ¶¶ 39, 46-50 of Barton address this limitation. For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" may be interpreted as actors associated with the "Infrastructure" element and related processes. Furthermore, it should be noted that the recited display only reflects "associations" among the claimed actor, process, and element. Associations *per se* merely refer to any relation between entities, items, etc., no matter how vague the relation may be. For example, the fact that Fig. 4 of Barton graphs relationships among an actor, process, and element is indicative of a display depicting an "association" among the recited actor, process, and element. Additionally, since the "Exec. Staff", "HR", "Legal", and "Sales" refer to potential interviewees for assessing compliance in various areas of a business (¶ 62), it is understood that these actors are somehow responsible for the respective area(s), which relate to the recited process and element, for which they may potentially be interviewed.

Applicant argues that "regarding claim 20, Barton fails to teach or suggest the display of interaction models between actors participating in an outsourcing." (Page 15 of Applicant's response) The Examiner respectfully submits that claim 20 does not define any specific interpretation of "interaction models." As discussed above, Barton produces a display that depicts a relationship among actors, processes, and elements (Fig. 4). Additionally, since the "Exec. Staff", "HR", "Legal", and "Sales" refer to potential

Art Unit: 3623

interviewees for assessing compliance in various areas of a business (¶ 62), it is understood that these actors are somehow responsible for the respective area(s), which relate to the recited process and element, for which they may potentially be interviewed. If an actor is somehow related to a given process(es) and/or element(s), an interaction among the respective actor, process(es), and/or element(s) is understood to exist.

In conclusion, Applicant's arguments are non-persuasive.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-9 and 12-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Furthermore, claims 1-9 and 12-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims 1-9, 12, and 13, based on Applicant's disclosure, the human user inputs all data and the computer merely regurgitates this data in the form of a display

Art Unit: 3623

(e.g., a matrix, as indicated in dependent claim 2); however, the computer itself does not perform any extraneous analysis of the data beyond what is needed to display the data in the form of a matrix. Therefore, it is not evident that any analysis of the organization is expressly performed, thereby rendering the claim vague and indefinite. As a matter of fact, all implied analysis is performed in the mind of a human user. The computer is merely used as a tool to output data input by the human user in the form of a matrix, which requires minimal processing and no express analysis on the part of the computer. Since all analysis is performed in the mind of the user, the results of the claimed invention are entirely subjective and non-repeatable, thereby failing to produce a concrete result. Due to this subjective nature, non-repeatability, and inconcrete nature of the claimed invention, the Examiner submits that the claimed invention was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation. Furthermore, since the specification fails to fill in the gap regarding who or what is performing analysis or even if any meaningful analysis occurs at all, the Examiner submits that claims 1-9, 12, and 13 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 2-13 are dependent from claim 1 and therefore inherit the same rejections under § 112, 1st paragraph.

As per claims 14-19, based on Applicant's disclosure, the human user inputs all data and the computer merely regurgitates this data in the form of a display (e.g., a matrix, as indicated in dependent claim 15); however, the computer itself does not perform any extraneous analysis of the data beyond what is needed to display the data in the form of a matrix. Therefore, it is not evident that any outsourcing is expressly performed, thereby rendering the claim vague and indefinite. As a matter of fact, all implied analysis is performed in the mind of a human user. The computer is merely used as a tool to output data input by the human user in the form of a matrix, which requires minimal processing and no express analysis on the part of the computer. Since all analysis is performed in the mind of the user, the results of the claimed invention are entirely subjective and non-repeatable, thereby failing to produce a concrete result. Due to this subjective nature, non-repeatability, and inconcrete nature of the claimed invention, the Examiner submits that the claimed invention was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation. Furthermore, since the specification fails to fill in the gap regarding who or what is performing analysis or even if any meaningful analysis occurs at all, the Examiner submits that claims 14-19 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 15-19 are dependent from claim 14 and therefore inherit the same rejections under § 112, 1st paragraph.

Claims 20-22 recite language that is similar to that recited in claims 1-9 and 12-19 in such a manner that the relevant portions of the § 112, 1st rejections of claims 1-9 and 12-19 are applied to claims 20-22 as well.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 7, 8, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites that the actor may be an organization, outsourcer for the organization, or a third party to the organization and the outsourcer. However, if an organization participates in outsourcing, then the organization itself is also an outsourcer regardless of whether or not it hires a third party to perform the outsourcing decisions. In other words, even if a third-party outsourcer working on behalf of the organization exists, the organization itself is also an outsourcer regardless of who actually negotiates the outsourcing contracts. Therefore, claim 8 is unclear because it recites the step of "developing a contract between the organization and the outsourcer for the outsourcer's furnishing of the associated process and element." If the organization is an outsourcer (i.e., it utilizes outsourcing), then how can it form a contract with itself? Furthermore, if the outsourcer is the one (either the organization

itself or a third party) in search of external parties to which to contract work, then the outsourcer is not actually furnishing the associated process and element. Instead, the entity to which the associated process and element are outsourced is actually furnishing them. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “outsourcer” in claim 7 is used by the claim to mean “supplier” or “the entity to which an operation is outsourced” (as per Applicant’s arguments), while the accepted meaning is “one who performs the practice of subcontracting manufacturing work to outside and esp. foreign or nonunion companies.” The term is indefinite because the specification does not clearly redefine the term.

Claim 8 is dependent from claim 7 and therefore inherits the same rejections under § 112, 2nd paragraph.

Claim 16 recites that the outsourcing may occur between an organization and an outsourcer, wherein the actor is either the organization, the outsourcer, or a third party to the organization and the outsourcer. However, if an organization participates in outsourcing, then the organization itself is also an outsourcer regardless of whether or not it hires a third party to perform the outsourcing decisions. In other words, even if a third-party outsourcer working on behalf of the organization exists, the organization itself is also an outsourcer regardless of who actually negotiates the outsourcing contracts. If

the organization is an outsourcer (i.e., it utilizes outsourcing), then how can it outsource with itself? Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclam Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “outsourcer” in claim 16 is used by the claim to mean “supplier” or “the entity to which an operation is outsourced” (as per Applicant’s arguments), while the accepted meaning is “one who performs the practice of subcontracting manufacturing work to outside and esp. foreign or nonunion companies.” The term is indefinite because the specification does not clearly redefine the term.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-9 and 12-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-9 and 12-22, since all analysis is performed in the mind of the user, the results of the claimed invention are entirely subjective and non-repeatable (discussed in more detail in the rejection under 35 U.S.C. § 112, 1st paragraph above),

thereby failing to produce a concrete result. Therefore, claims 1-9 and 12-22 are deemed to be non-statutory for failing to produce a concrete result.

Appropriate correction is required.

In light of the numerous rejections under 35 U.S.C. §§ 101 and 112, 1st and 2nd paragraphs presented above, the following art rejection reflects Examiner's best understanding of the claimed invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-7 and 12 are rejected under 35 U.S.C. 102(a), (e) as being anticipated by Barton et al. (US 2002/0059093).

Barton discloses a method for illustrating an operation of an organization comprising:

[Claim 1] defining the operation as a value chain, the value chain containing a plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources",

and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

associating a process of the value chain with an element that is subject to the process (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

associating an actor with the associated process and element (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes); and

displaying on a single display the associated actor, process, and element as associated (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

[Claim 2] wherein defining the operation comprises plotting the value chain on a matrix (Fig. 4),

wherein associating the process and the element comprises mapping a plurality of elements against the value chain on the matrix (Fig. 4), and

wherein associating the actor with the associated process and element comprises indicating the actor of the associated process and element at an intersection on the matrix corresponding to the associated process and element (Fig. 4); and

wherein displaying comprises displaying the matrix on a computer user interface (Fig. 4; ¶¶ 47-50);

[Claim 3] wherein the plurality of elements are grouped by class, business unit, and geography of the organization (Fig. 4 indicates that the elements, such as “Infrastructure”, fall under a given class, e.g., “Compliance Assessment Areas”; Figs. 6 and 7 specify a business/company location, i.e., geography, corresponding to the elements);

[Claim 4] wherein the class defines commonalities among a group of elements (Fig. 4 indicates that the elements, such as “Infrastructure”, are common to a given class, e.g., “Compliance Assessment Areas”);

[Claim 5] wherein the operation comprises an information technology operation, and wherein the element comprises one of a client, a server, an enabler, and an application (Figs. 4, 6, 7, 12, 13; ¶¶ 62, 66-69 -- Data from the questionnaire metrics chart and resulting compliance risk assessment is used to generate the quality function deployment (QFD) matrix. Therefore, the elements from Fig. 4 are linked to, or comprise, related IT applications, including “Information Systems” (Fig. 12) and “30.13 Product Development” and “Y2K Physical Product Upgrades” (Fig. 13));

[Claim 6] wherein the actor of the associated process and element comprises an actor responsible for furnishing the associated process and element (Fig. 4; ¶¶ 60-62 --

For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors responsible for furnishing the associated process and element);

[Claim 7] wherein the actor comprises one of the organization, an outsourcer for the organization, and a third party to the organization and the outsourcer (Fig. 4; ¶¶ 60-62 -- Actors within the organization become owners of certain elements and processes);

[Claim 12] wherein the process is defined according to an industry standard (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to compliance risks based on such areas as regulatory requirements (¶ 70), i.e., industry standards).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 8, 9, and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al. (US 2002/0059093), as applied to claims 1, 6, and 8 above.

[Claim 8] Barton discloses that the actor is an outsourcer and that a contract is developed between the organization and the outsourcer, as implied by the fact that the business analyzes its outsourcing (¶ 69) and supplier agreements (¶ 70). However,

Barton does not expressly disclose that the outsourcer is contracted to furnish the associated process and element, yet Official Notice is taken that it is old and well-known in the art of outsourcing to outsource any processes typically associated with a business, especially where such outsourcing would lower costs for the business. For example, many businesses find it more cost effective to outsource their regulatory monitoring and IT functions (both of which are related to processes and elements, as shown in Figures 4, 12, and 13). Since Barton is directed toward assessing business risks, including those associated with outsourcing and supplier agreements, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Barton to expressly develop a contract between the organization and the outsourcer for the outsourcer's furnishing of the associated process and element in order to facilitate the outsourcing of business processes and elements that are determined to be more efficiently and inexpensively performed by an outside entity while maintaining sufficient compliance monitoring standards in effect.

[Claim 9] Barton does not specify whether or not the evaluated business happens to be a company participating in a merger; however, Barton does perform business risk evaluations (¶¶ 69-70). Furthermore, Official Notice is taken that it is old and well-known in the art of merger planning for companies involved in the merger to consider various risk factors of each business when ultimately deciding to complete the merger or not. This assessment provides each business with a more realistic understanding of the pros and cons involved with the merger. Since Barton lays out groundwork for evaluating business risks, the Examiner asserts that it would have been obvious to one

of ordinary skill in the art at the time of Applicant's invention to market Barton's invention to companies participating in a merger in order to expand Barton's customer base, thereby increasing Barton's likelihood to generate profit. It should also be noted that the fact that the "actor comprises one of a first company participating in a merger and a second company participating in the merger" does not affect the structure or functionality recited in the claimed invention; therefore, the patentable weight merited by such a limitation is questionable.

[Claim 13] In order to evaluate the various compliance assessment areas and related business risks and assign processes and elements to owners, or actors (as disclosed in Figs. 4, 12, 13; ¶¶ 60-70), users of Barton's invention must at some level perform the steps of relating, developing, contacting, fulfilling, operating, advising, and managing. While Barton does not expressly define these steps as processes that are mapped out against related elements, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize these specific process labels (i.e., relate, develop, contact, fulfill, operate, advise, and manage) since Barton's users effectively perform these processes, thereby allowing Barton's invention to more comprehensively address processes specific to various types of organizations.

Barton discloses a method for illustrating a scope of an outsourcing comprising:

[Claim 14] defining a value chain containing a plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement."

"Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

defining a collection of elements, wherein the collection of elements is subject to the plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

associating a process of the plurality of processes with an element of the collection of elements (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

associating an actor with the associated process and element, wherein the actor furnishes the associated process and element (Figs. 4, 6, 7, 11, 12, 13, 17; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

[Claim 15] wherein associating the process of the plurality of processes with the element of the collection of elements comprises mapping the plurality of processes against the collection of elements in a matrix, and wherein associating the actor with the associated process and element comprises listing the actor at an intersection of the

Art Unit: 3623

associated process and element within the matrix, and wherein displaying the scope comprises displaying the populated matrix (Fig. 4);

[Claim 17] wherein the process comprises a service measure, and the method further comprises associating a service level with the associated process and element and displaying the associated process, element, and service level on the computer user interface (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to compliance risks based on such areas as supplier agreements (¶ 70), i.e., expected service levels);

[Claim 19] wherein the plurality of processes comprises one of information technology functions, human resource functions, finance and accounting functions, procurement functions, call center functions, back-office functions, and mid-office functions (Figs. 4, 6, 7, 12, 13; ¶¶ 62, 66-69 -- Data from the questionnaire metrics chart and resulting compliance risk assessment is used to generate the quality function deployment (QFD) matrix. Therefore, the elements from Fig. 4 are linked to, or comprise, related IT applications, including "Information Systems" (Fig. 12) and "30.13 Product Development" and "Y2K Physical Product Upgrades" (Fig. 13). ¶¶ 69-70 discusses various finance and accounting and procurement functions).

As per claims 14 and 16, Barton discloses that the actor is an outsourcer and that a contract is developed between the organization and the outsourcer, as implied by the fact that the business analyzes its outsourcing (¶ 69) and supplier agreements (¶ 70). However, Barton does not expressly disclose that a scope for the outsourcing

based on the associated actor, process, and element is defined and displayed on a single display, yet Official Notice is taken that it is old and well-known in the art of outsourcing to outsource any processes typically associated with a business, especially where such outsourcing would lower costs for the business. For example, many businesses find it more cost effective to outsource their regulatory monitoring and IT functions (both of which are related to processes and elements, as shown in Figures 4, 12, and 13). Since Barton is directed toward assessing business risks, including those associated with outsourcing and supplier agreements, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Barton to expressly define and display on a single display a scope for the outsourcing based on the associated actor, process, and element (claim 14) wherein the outsourcing is between an organization and an outsourcer for the organization, and wherein the actor is one of the organization, the outsourcer, and a third party to the organization and the outsourcer (claim 16) in order to facilitate the outsourcing of business processes and elements that are determined to be more efficiently and inexpensively performed by an outside entity while maintaining sufficient compliance monitoring standards in effect.

[Claim 18] Barton discloses the step of associating a cost with associated process and element and displaying the associated process and element on the computer user interface (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to compliance risks based on such areas as carrying cost, financial controls, and expense

approvals (¶¶ 69-70), i.e., cost for furnishing the associated process and element); however, Barton does not expressly teach that the cost is displayed on the computer user interface. The Examiner submits that it is old and well-known in the art that displaying multiple factors of an analysis on a user interface facilitates quick and efficient understanding of the relationships among the various factors, thereby allowing a user to more comprehensively glean the implications of such relationships. Since Barton teaches the display of various processes and elements and Barton discloses that cost contributes to the business risk evaluation, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Barton to display an associated cost along with the process and element in order to facilitate a quick and efficient understanding of the relationships among the various factors, thereby allowing a user to more comprehensively glean the implications of such relationships.

Barton discloses a method for illustrating interactions between an organization and an outsourcer participating in an outsourcing comprising:

[Claim 20] defining a value chain containing a plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

defining a collection of elements, wherein the collection of elements is subject to the plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

associating the plurality of processes with the collection of elements (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

displaying the associations between the plurality of processes and the collection of elements (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

assigning actors for the associated processes and elements, wherein the actors are either the organization, the outsourcer for the organization, or a third party to the organization and the outsourcer (Fig. 4; ¶¶ 60-62 --- Actors within the organization become owners of certain elements and processes);

displaying the actors for the associated processes and elements (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement."

"Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

[Claim 22] wherein associating the plurality of processes with the collection of elements comprises mapping the plurality of processes against the collection of elements in a matrix (Figs. 4, 12, 13),

wherein assigning the actors comprises listing the actors at intersections of processes and elements in the matrix (Fig. 4),

wherein displaying the plurality of processes and the collection of elements comprises displaying the matrix (Figs. 4, 12, 13), and

wherein the interaction models comprise process maps indicating a swim-lane boundary across which the interactions occur (Figs. 4, 12, 13).

As per claims 20-22, Barton discloses that the actor is an outsourcer and that a contract is developed between the organization and the outsourcer, as implied by the fact that the business analyzes its outsourcing (¶ 69) and supplier agreements (¶ 70). However, Barton does not expressly disclose that a scope for the outsourcing based on the associated actor, process, and element is defined and displayed, yet Official Notice is taken that it is old and well-known in the art of outsourcing to outsource any processes typically associated with a business, especially where such outsourcing would lower costs for the business. For example, many businesses find it more cost effective to outsource their regulatory monitoring and IT functions (both of which are related to processes and elements, as shown in Figures 4, 12, and 13). Since Barton is

directed toward assessing business risks, including those associated with outsourcing and supplier agreements, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Barton to expressly identify, along with the value chain, interactions between the organization and the outsourcer, create interaction models for the identified interactions, and display on a computer user interface the interaction models (claim 20), wherein the interaction models define a sequence by which to complete the plurality of processes and information that is to be passed between the organization and the outsourcer (claim 21) in order to facilitate the outsourcing of business processes and elements that are determined to be more efficiently and inexpensively performed by an outside entity while maintaining sufficient compliance monitoring standards in effect.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susanna M. Diaz
Susanna M. Diaz
Primary Examiner
Art Unit 3623

December 27, 2005